

### **REMARKS**

This responds to the Office Action mailed on June 17, 2004.

By way of this amendment, claims 8 and 22 are amended, claim 24 is added, and no claims are canceled. As a result, claims 8-10, 12, 15, 21-22, and 24 are now pending in this application.

For the convenience of the Examiner, Applicant's remarks concerning the claims will be presented in the same order in which the Examiner presented them in the Office Action.

### **Amendment to the Title**

The title has been amended to more accurately reflect the claimed subject matter by substituting "Cameras" for "Camera" and by adding "And Associated Methods".

### **Amendment to Claims 8 and 22**

Claim 8 has been amended by deleting the language "and optionally to store the digital text file as a separate file in the memory".

Claim 22 has been amended by inserting the language "if the captured audio input is converted into text data, then". No new matter has been introduced.

The amendments to the claims are made to satisfy Applicant's preferences, not necessarily to satisfy any legal requirement(s) of the patent laws, and they are not intended to limit the scope of equivalents to which any claim element may be entitled.

### **New Claim 24**

New claim 24 has been added to provide Applicant with additional protection to which Applicant is entitled. New claim 24 is dependent upon independent claim 8 and recites that if the captured audio input is converted into a digital text file, the processor is to store the digital text file as a separate file in the memory. Support may be found, for example, on page 4, beginning line 3, which states "Further, the text can be separately stored in parallel to the photo/text file to provide a level of redundancy." Support may also be found, for example, on page 3, beginning

line 3, which states “The processor can process the speech and then route the speech to the memory for storage.”

Thus, new claim 24 is supported by the original disclosure. No new matter has been introduced.

**Rejection of Claims 8-10**  
**Under 35 U.S.C. §112, First Paragraph**

The Examiner rejected claims 8-10 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner asserted that the claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The Examiner stated that claim 8 contains the language “and optionally to store the digital text file as a separate file in the memory”. The Examiner asserted that this language is not supported in the specification or drawings, because neither allows the maker or user a means to select the optional function.

The limitation of claim 8 that was referred to by the Examiner has been canceled without prejudice.

It should be noted that new claim 24, which is dependent upon claim 8, recites that if the captured audio input is converted into a digital text file, the processor is to store the digital text file as a separate file in the memory. Claim 24 does not recite or imply any “means to select” an optional function, which “means” was asserted by the Examiner to be unsupported in the original disclosure. Therefore, new claim 24 should also fully comply with the written description requirement per 35 U.S.C. §112, first paragraph.

In response to the Examiner’s comment in the most recent Office Action that Applicant is attempting to combine multiple embodiments in a single claim, Applicant respectfully asserts that in any patent or patent application, each claim thereof may indeed be directed to more than one embodiment of the inventive subject matter disclosed. This is in complete accord with the patent laws.

Now, regarding independent claim 8 specifically, it should be clear that support may be found in the original disclosure for each of the limitations of claim 8 shown in the table below, which is provided for the Examiner's convenience:

CLAIM 8 LIMITATION	LOCATION WHERE SUPPORT IS PROVIDED (for example)
"wherein the processor is to convert captured audio input provided by the microphone into either a digital text file or a compressed audio file"	Page 3, line 29, through page 4, line 2.
"wherein the processor is further to convert the captured image into a digital image file"	Page 3, lines 11-12. Original claim 12, line 3.
"wherein, if the captured audio input is converted into a digital text file, the processor is to store the digital image file and the digital text file as a single composite digital data file in the memory"	Page 3, line 30 through page 4, line 1. Page 4, lines 16-17. Original claim 14.
"wherein, if the captured audio input is converted into a compressed audio file, the processor is to store the digital image file and the compressed audio file as separate files in the memory"	Page 3, lines 29 through page 4, line 2. Page 4, lines 6-10.

For the above reasons, Applicant respectfully requests that the rejection of claims 8-10 under 35 U.S.C. §112, first paragraph, be withdrawn.

**Rejection of Claim 12 under 35 U.S.C. §103(a) as Unpatentable  
over Kondo in View of Shipp**

Independent claim 12 was rejected under 35 U.S.C. §103(a) as being unpatentable over Kondo et al. (U.S. 5,786,851) in further view of Shipp (U.S. 6,031,526).

Kondo discloses a method of operating a digital electronic camera that provides simultaneous recording of image and audio signals (col. 15, lines 48 *et seq.*)

Shipp discloses a complex system for generating electronic and printed medical records that provides automatic integration of captured video still images and voice-dictated information concerning the image (see Abstract). As stated in col. 4, lines 6-8, "The combination of the

readable text and a viewable image then constitutes a comprehensive medical record which can be stored in memory 22 . . .”.

It should be noted that computer memory 22 (FIG. 1, described in col. 3, lines 37-38 of Shipp) constitutes a separate element from the video camera 11 within Shipp’s complex system. This is to be contrasted with Applicant’s memory 110, which forms part of digital camera 100 (FIG. 1). Applicant’s camera is intended to be a portable, handheld digital camera, in contrast to Shipp’s complex system, which is intended to be used by surgeons in a hospital (col. 3, lines 12-28).

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, the prior art reference (or references when combined) must teach or suggest every limitation of the claim. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA, 1974). MPEP §2143.

The Examiner’s asserted combination of Kondo in view of Shipp fails to teach or suggest all of the claim limitations present in independent claim 12, so a *prima facie* case of obviousness has not been established.

For example, one limitation of claim 12 that this combination of references fails to disclose is storing the text data and the digital image data as a composite digital file in a memory of the camera [emphasis added]. As Applicant asserted above, Shipp discloses storing text data and digital image data in a memory separate from the camera.

For the above reasons, claim 12 should be found to be allowable over any combination of Kondo and Shipp, and Applicant respectfully requests that the rejection of claim 12 under 35 U.S.C. §103(a) as being unpatentable over Kondo in view of Shipp should be withdrawn.

Claim 21, which depends from claim 12 and incorporates all of the limitations therein, is also asserted to be allowable for the reasons presented above.

**Rejection of Claim 21 under 35 U.S.C. §103(a) as Unpatentable  
over Kondo in View of Shipp and Fukuoka**

Claim 21 was rejected under 35 U.S.C. §103(a) as being unpatentable over Kondo in further view of Shipp as applied to claim 12, and further in view of Fukuoka (U.S. 6,104,430).

Kondo and Shipp were discussed earlier.

Fukuoka discloses a digital camera that can accept various types of input/output cards or memory cards (see Abstract). FIG. 9 (not FIG. 19 as stated by the Examiner in the most recent Office Action) of Fukuoka shows a block diagram of the organization of files within a memory card 16, in which separate image files 60a-60c and audio files 61a and 61b are stored.

As stated above, to establish a *prima facie* case of obviousness under 35 U.S.C. §103, the prior art reference (or references when combined) must teach or suggest every limitation of the claim.

It should be noted that, like Kondo, Fukuoka fails to disclose anything whatsoever concerning converting audio input into text data.

Applicant asserted above, regarding the rejection of independent claim 12, that the combination of Kondo and Shipp fails to disclose storing text data and digital image data as a composite digital file in a memory of the camera [emphasis added]. Fukuoka also fails to disclose this, because Fukuoka fails to disclose converting audio input into text data.

For the above reasons, claim 21 should be found to be allowable over any combination of Kondo, Shipp, and Fukuoka, and Applicant respectfully requests that the rejection of claim 21 under 35 U.S.C. §103(a) as being unpatentable over Kondo in view of Shipp and Fukuoka should be withdrawn.

**Rejection of Claims 8-10, 15, and 22 under 35 U.S.C. §103(a)  
as Unpatentable over Kondo in View of Shipp and Fukuoka**

Claims 8-10, 15, and 22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kondo et al., further in view of Shipp, and in further view of Fukuoka.

Kondo, Shipp, and Fukuoka were discussed earlier.

As stated above, to establish a *prima facie* case of obviousness under 35 U.S.C. §103, the prior art reference (or references when combined) must teach or suggest every limitation of the claim.

Applicant asserted above, regarding the rejection of claim 12, that the combination of Kondo and Shipp fails to disclose storing a digital image file and a digital text file as a single composite digital file in the memory of the camera [emphasis added]. Note that independent claim 8 recites the memory as an element of the camera.

The references, whether taken individually or in combination, fail to disclose storing a digital image file and a digital text file as a single composite digital file in the memory of the camera [emphasis added].

Regarding independent claim 15, the references, whether taken individually or in combination, also fail to disclose storing a single digital data file in a memory of the camera [emphasis added].

For the above reasons, independent claims 8 and 15 should be found to be allowable over any combination of Kondo, Shipp, and Fukuoka, and Applicant respectfully requests that the rejection of claims 8 and 15 under 35 U.S.C. §103(a) as being unpatentable over Kondo in view of Shipp and Fukuoka should be withdrawn.

Claims 9-10, which depend from independent claim 8, and claim 22, which depends from independent claim 15, are also asserted to be allowable for the reasons presented above.

#### **Additional Elements and Limitations**

Applicant considers additional elements and limitations of claims 8-10, 12, 15, 21-22, and 24 to further distinguish over the cited references, and Applicant reserves the right to present arguments to this effect at a later date.

AMENDMENT UNDER 37 C.F.R. 1.116 – EXPEDITED PROCEDURE

Serial Number: 09/414,400

Filing Date: October 7, 1999

Title: SPEECH-TO-TEXT CAPTIONING FOR DIGITAL CAMERAS AND ASSOCIATED METHODS (as amended)

Assignee: Intel Corporation

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Dkt: 884.166US1 (INTEL)

**Conclusion**

Applicant respectfully submits that claims 8-10, 12, 15, 21-22, and 24 are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney, Walter W. Nielsen (located in Phoenix, Arizona) at (602) 298-8920, or the below-signed attorney (located in Minneapolis, Minnesota) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 16 day of November, 2004.

Chris Hammond

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Signature